

Application No. 09/663,872

REMARKS

Claims 1-25 are pending.

Claims 1-25 stand rejected.

Claim Rejections – 35 U.S.C. §102

Claims 21-23 were rejected under 35 U.S.C. §102(b) as being anticipated by Kawaski et al. (US Patent 5,576,075) which rejection is traversed.

Claim 21 has been amended to further comprise a second ultrasonicator adapted to ultrasonicate the filter member. The Examiner has not pointed out where in the cited reference to Kawasaki et al. there is found a second ultrasonicator adapted to ultrasonicate the filter member. Claims 22 and 23 depend either directly or indirectly from claim 21, and are thus also believed to be in condition for allowance. Applicants direct the Examiner's attention to new claim 27, to which these comments also apply.

Claims 1, 2, 11 and 14 were rejected under 35 U.S.C. §102(b) as being anticipated by Min et al. (US Patent 4,112,549) which rejection is traversed.

Claim 1 has been amended and claim 2 has been cancelled. Claim 1 as amended is not anticipated by Min et al.. Min et al. does not teach coating the resulting sonicated stream onto a receiver surface wherein the receiver surface is a photoreceptor substrate. Claims 11 and 14 depend from claim 1, and are thus also believed to be in condition for allowance.

Claim Rejections – 35 U.S.C. §103

Claims 1-2, 5-6, 8-10, 12-19 and 24-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kawaski et al. (US Patent 5,576,075) which rejection is traversed.

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Claim 1 has been amended to include the coating of the resulting sonicated stream onto a photoreceptor substrate and the Examiner has not pointed out where in Kawaski et al. this combination can be found. Claims 2 and 14 have been cancelled.

With regard to claims 5 and 6, the Examiner has failed to show how the reference to Kawaski et al. teaches in combination the elements of claim 1 with agglomerated primary particles in the stream in an amount of from about 0 to about 60 weight percent based on the total weight of the stream. Further, the Examiner has not pointed out in Kawaski et al. where there is shown de-agglomerated primary particles of a volume average diameter of from about 0.005 to about 20 micrometers together with a resulting sonicated stream coated onto a photoreceptor substrate. The Examiner has not pointed to any suggestion, motivation or incentive for modifying Kawasaki et al. to arrive at the Applicants invention. See *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989) ("the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification") (quoting *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)).

With regard to claim 8, the Examiner has not pointed out in Kawaski et al., either alone or in combination, a filter described as removing a contaminate. Filters can be used for many different purposes unrelated to contamination removal. For example, the filter may be used to reduce the amount of the solvent in the solution or the filter may be used to remove the amount of solids in the solution. The Examiner has not pointed to any suggestion, motivation or incentive for filtering contaminants.

With regard to claim 9, the Examiner has failed to point out where in Kawaski et al., there is found, either alone or in combination, a contaminant with an average diameter particle size greater than the average diameter of ultrasonically de-agglomerated particles.

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The Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). *See also In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.")

With regard to claims 10, 12, and 13 the Examiner has not shown where in Kawaski et al. there can be found a continuous phase liquid solvent, a sonication that is accomplished with at least one ultrasonic member and wherein said ultrasonic member comprises from about 1 to about 10 ultrasonic horns, together in combination with a resulting sonicated stream coated onto a photoreceptor substrate.

With regard to claims 15 through 19, the Examiner has not pointed out where in Kawaski et al. there can be found in combination sonication the filter media with a second sonicator, measuring the stream pressure just prior to filtering, re-agglomerating the primary particles, and analyzing the sonicated stream for third particles arising from the degradation of the primary particles during sonication. Applicants direct the Examiner's attention to new claim 26, to which these comments also apply.

The Federal Circuit has repeatedly warned that the requisite motivation must come from the prior art, not Applicant's specification. *See In re Dow Chem. Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988) ("there must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure"). Using an Applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of §103, which requires judging obviousness at the point in time when the invention was

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made. See *Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

Claims 3, 4, 7 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kawaski et al. as applied to claims 1-2, 5-6, 8-10, 12-19 and 24-25 above, and further in view of Hochberg (US Patent 3,890,240) which rejection is traversed.

Claim 3 has been cancelled and incorporated into claim 1. The Examiner has failed to point out any suggestion, motivation or incentive in either reference for combining the teachings of Kawasaki et al. with Hochberg to arrive at the Applicants coated photoreceptor substrate of claim 3.

With regard to claims 4 and 7, the Examiner has not pointed out where in Kawasaki et al. and further in view of Hochberg there is disclosed that the primary particles are toner particles comprised of a mixture of at least one colorant and a resin (claim 4) or that the primary particle is at least one colorant (claim 7).

With regard to claim 20, the Examiner has failed to point out where in Kawasaki et al. and further in view Hochberg there is disclosed the combination of ultrasonicing a stream of a dispersion of photosensitive particles, filtering the resulting stream, and coating the stream onto a receiver surface.

The Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kawaski et al. as applied to claims 1-2, 5-6, 8-10, 12-19 and 24-25 above, and further in view of Min et al. (US Patent 4,112,549) which rejection is traversed.

With regard to claim 11, the Examiner has failed to establish a prima facie case of obviousness. The Examiner has not pointed out in either reference

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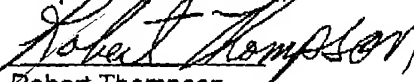
any suggestion, motivation, or incentive for a coated photoreceptor substrate coated from a sonicated stream of agglomerated primary particles wherein the stream further comprises a continuous gas phase carrier vehicle.

The Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

The application and claims are believed to be in a condition for allowance in their present form and which allowance is respectfully requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, the Examiner is hereby authorized to call Applicant's Attorney, Robert Thompson, at Telephone Number (585) 423-2050, Rochester, New York.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE:

IN THE CLAIMS:

Claims 2, 3, 13, and 14 have been cancelled.

1. (Amended) A method comprising:

sonicating a stream containing a dispersion comprised of agglomerated primary particles; [and] filtering the resulting sonicated stream containing a dispersion comprised of de-agglomerated primary particles and further comprising coating the resulting sonicated stream onto a receiver surface wherein the receiver surface is a coated photoreceptor substrate and wherein the de-agglomerated primary articles are separated in the resulting sonicated stream.

4. (Amended) The method in accordance with **claim 1**, wherein the primary particles are toner particles comprised of a mixture of at least one colorant and a resin.

21. (Amended) An apparatus comprising:

an ultrasonicator adapted to ultrasonicate a stream of a liquid dispersion of agglomerated primary particles; [and] a filter member adapted to filter the resulting ultrasonicated stream containing a dispersion of de-agglomerated primary particles; and

further comprising a second ultrasonicator adapted to ultrasonicate the filter member.

Claims 26 and 27 are new.